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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,525	01/13/2004	Nady E. Nady	5032-104 US	2340

7590

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,525

Applicant(s)

NADY, NADY E.

Examiner

David Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-16 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-16 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8, 10-16, 19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (5,868,668) in view of Francis et al. (5,072,720).

Weiss discloses a surgical retractor 10 comprising pivotally connected cross arms 35, 13 with a plurality of blades 28, 36 and rearward end portions with hand grips 54, 11 (see Figs. 1 and 4). The connection between the cross arms permits both pivoting motion and longitudinal motion to lock the blades relative to each other (see, e.g., Figs. 4-6). Additional devices such as illumination and suction devices may be removably attached to a clip 48, 50 of a cross arm (see Fig. 1 and col. 4, lines 26-30). The device is capable of being reused (that the device may be made with removable disposable blades to reduce contamination risk does not preclude the inherent capability of the tool to be sterilized and reused in the ordinary manner of surgical instruments). The device is used in a procedure to dilate a vaginal cavity wherein the device is inserted into the vaginal cavity and then the blades of the device are spread and locked open (see Fig. 14 and col. 4, lines 5-30). Furthermore, it is implicit that the additional components disclosed, including the illumination and suction means, are

Art Unit: 3732

optionally used in the procedure (id.). Thus, Weiss discloses the claimed invention except for the incrementally adjustable locking device. Francis et al. disclose a similar device having an incrementally adjustable locking device 26, 40 to lock the device open in a smooth and convenient manner and allow a physician to use both hands, if needed, for the examination and/or treatment of the patient (see, e.g., Figs 1 and 2; col. 1, lines 36-38, 46-48 and 55-61; col. 3, lines 6-10; and col. 4, lines 32-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retractor of Weiss with an incrementally adjustable locking device, in view of Francis et al., in order to lock the device open in a smooth and convenient manner and allow a physician to use both hands, if needed, for the examination and/or treatment of the patient. Moreover, it is noted that to make the lock of Weiss adjustable would have also been obvious since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954). It also would have been obvious to have formed the blades of a flexible elastomer, or of any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (5,868,668) in view of Francis et al. (5,072,720) and further in view of Nwawka (6,036,638).

The device of the combination of Weiss in view of Francis et al. discloses the claimed invention except for the elastomeric membrane. Nwawka discloses a similar device having an elastomeric membrane connecting the arms in order to improve the physician's visibility during a gynecological examination and to protect the vaginal region from pinching due to moving parts (see Fig. 4; Abstract; col. 1, lines 5-23; and col. 3, lines 32-42, 54-56 and 60-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retractor of Weiss in view of Francis et al. with an elastomeric membrane connecting the blades, in view of Nwawka, in order to to improve the physician's visibility during a gynecological examination and to protect the vaginal region from pinching due to moving parts.

Response to Arguments

In response to applicant's argument that Weiss is directed to vertical and not lateral motion, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Here, the device may be turned sideways, for example, to achieve lateral motion. It is also noted that the motion is in one plane.

In response to applicant's argument that Nwaka does not disclose "connecting" the blades by the membrane, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Here, since the unitary membrane is placed over the blades, it necessarily connects the blades, at least under a broadest reasonable interpretation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

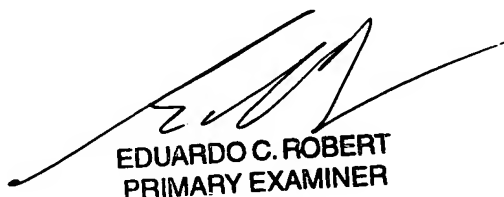
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
25 July 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER